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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,387	07/20/2005	Hans-Erik Hjelmroth	04305/0202820-US0	5182
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DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			EXAMINER EOFF, ANCA	
			ART UNIT	PAPER NUMBER
			1795	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/533,387	<b>Applicant(s)</b> HJELMROTH ET AL.	
	<b>Examiner</b> ANCA EOFF	<b>Art Unit</b> 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-2, 4-16, 18-40, 42-51 is/are pending in the application.
- 4a) Of the above claim(s) 18-32 and 42-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-16 and 33-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-2, 4-16 and 33-40 are pending in the application. Claims 3, 17 and 41 are canceled. Claims 18-32 and 42-51 are withdrawn from consideration.

### ***Claim Objections***

2. Claim 37 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form.

Claim 37 depends on claim 9 and recites the heating step c) after the drying step b). However, the applicant's amendment introduces in claim 9 the limitation of baking step c) after the drying step b).

### ***Claim Rejections - 35 USC § 102 & 35 USC § 103***

3. The following is a quotation of the appropriate paragraph of 35 U.S.C. 102 that forms the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-2, 4-14, 16 and 33-39 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakazawa et al. (US Pg-Pub 2002/0023566).

With regard to claims 1, 9 and 37, Nakazawa et al. disclose a printing plate and a method of computer-to-cylinder lithographic printing comprising the steps of:

- forming an image directly onto the plate material by an ink-jet recording process which comprises ejecting an ink from a recording head to prepare a printing plate (par.0018 and par.0182);
- heating the image to strengthened it (par.0182).

Nakazawa et al. further disclose that the ink comprises a resinous material (P), which may be acrylamide copolymers or methacrylamide copolymers (par.0139). The (meth)acrylamide copolymers are equivalent to copolymers with acid groups wherein all of said acid groups have been converted to the corresponding amide of the instant application.

The process of heating of Nakazawa et al. (par.0182) is equivalent to the drying the substrate and baking the ink into the substrate of the instant application, as disclosed on page 11, lines 1-6 of the instant application.

The printing plate comprising the plate material and the ink layer imagewise-deposited thereon is equivalent to the lithographic printing form of the instant application.

Claims 2 and 10 are product-by-process claims.

Claims 2 and 10 refer to the amide monomer of the copolymer of claims 1 and 9 and introduce the limitation "wherein the amide is made from an amine selected from the group consisting of ammonium, an alkyl amine and a dialkyl amine". The process limitation does not give any patentable weight to the claimed product.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Since Nakazawa et al. disclose an acrylamide and methacrylamide copolymers used in the ink composition, it is the examiner's position that the acrylamide and methacrylamide copolymers of Nakazawa et al. are identical to the polymer in the instant application. In the alternative, the polymer of the instant application is obvious over the acrylamide and methacrylamide copolymers of Nakazawa et al..

With regard to claims 4 and 11, Nakazawa et al. disclose that the ink comprises acrylamide copolymer and methacrylamide copolymers (par.0139), which are equivalent to the acrylic copolymer and the methacrylic copolymer of the instant application wherein all the acid groups are converted to amide groups.

With regard to claims 5, 12, 34-35 and 38-39 Nakazawa et al. disclose that the weight average molecular weight of the resinous material should preferably be between 10,000 and 500,000 (par.0138).

With regard to claims 8, 16, 33 and 36, Nakazawa et al. further disclose that metal plates comprising aluminum are preferred (par.0121).

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With regard to claims 6-7 and 13-14, Nakazawa et al. further disclose that the ink may comprise pigments, such as molybdenum red, chrome yellow, titanium yellow, cobalt green (par.0143) which are equivalent to the transition metal complexes of the instant application. The pigments may be comprised in the ink in an amount between 0.01 and 5% by weight of the entire ink quantity (par.0145).

5. Claims 15 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazawa et al. (US Pg-Pub 2002/0023566) in view of Frenkel et al. (WO 01/34394).

With regard to claims 15 and 40, Nakazawa et al. teaches the heating of the printing plate comprising the imagewise-deposited ink layer (par. 0182) but fail to disclose a heating temperature above 150°C and respectively a temperature in the range of 170-220°C.

Frenkel et al. disclose a computer-to-plate method (CTP) for producing an offset lithographic printing plate by employing an inkjet fluid that can be easily dried on an uncoated lithographic plate (abstract). The computer-to-plate method comprises the steps of providing an inkjet marking fluid, jetting said marking fluid onto a printing surface and drying said marking fluid on said printing surface (page 4, lines 21-26).

The computer-to-plate method of Frenkel et al. is equivalent to the computer-to-cylinder lithographic printing method of Nakazawa et al., as taught in par.0018 and 0182.

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The inkjet fluid /marking fluid of Frenkel et al. comprises a polymer selected from the group of urethane, acrylates, methacrylates, styrenes, vinyl acetates and other vinyl esters, ethylene, butadiene, vinyl chloride, vinylidene chloride and copolymers of said materials (page 9, lines 4-15), which are equivalent to the resinous material (P) of the ink of Nakazawa et al.

Frenkel et al. further disclose that heating of the image-bearing plate up to approximately 200°C may be performed in order to improve the abrasion resistance of the jetted image to increase run length (page 10, lines 3-6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to heat the plate having the imagewise-deposited ink layer of Nakazawa et al. up to 200°C, as taught by Frenkel et al., in order to improve the abrasion resistance of the jetted image to increase run length (Frenkel et al., page 10, lines 3-6).

### ***Response to Arguments***

6. The rejection of claims 1-2, 4-14, 16, 33-36 and 38-39 under 35 USC 102(e) or under 35 USC 103(a) over Matzinger et al. (US Patent 6,376,611) is withdrawn following the applicant's amendment to claim 1.

7. Applicant's arguments, see pages 12-15 of the Remarks, filed on August 04, 2008, with respect to the rejection of claims 1-6, 8-13, 16, 33 and 36 under 35 USC 102(e) over Aurenty et al. (US Patent 6,472,054) and the rejection of claims 1-6, 9-13,

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15, 17, 33-40 under 35 USC 102(e) over Cottrell et al. (WO 00/29493) have been fully considered and are persuasive. The above-mentioned rejections have been withdrawn.

However, upon further consideration, new grounds of rejection are shown in paragraphs 3-5 of the Office Action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANCA EOFF whose telephone number is (571)272-9810. The examiner can normally be reached on Monday-Friday, 6:30 AM-4:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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